

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 26, 2004 (*Office Action*). Claims 1-25, 46-70, and 88-92 were pending in the Application and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Examiner rejects all pending Claims under 35 U.S.C. §103(a) as being unpatentable over various combinations of references. To establish obviousness of a claimed invention under §103, all claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03. Furthermore, to render the claims *prima facie* obvious, a proposed modification or combination of references must not change the principle of operation of the reference or references being modified. M.P.E.P. §2143.01.

In addition, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or motivation supporting the combination. M.P.E.P. §2143.01. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis in original). Furthermore, the invention cannot be viewed as a blueprint drawn by the inventor to piece together prior art. *See Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1138 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”). Indeed, using the invention as a blueprint is the essence of impermissible hindsight. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999) (“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.”).

Claims 1-15, 19, 20, 24, 25, 46, 48-61, 65, 66, 69, and 70

The Examiner rejects Claims 1-15, 19, 20, 24, 25, 46, 48-61, 65, 66, 69, and 70 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,301,359, which issued to Van Den Heuvel et al. ("*Van den Heuvel*"), in view of U.S. Patent No. 5,594,947, which issued to Grube et al. ("*Grube*"), and U.S. Patent No. 6,101,379, which issued to Rahman et al. ("*Rahman*").

Applicants' independent Claim 1 recites:

A method for brokering resources of a wireless communications network, comprising:

receiving a request for a wireless service at a geographic region;

selectively determining an availability of the wireless service for at least two service providers available at the geographic region based on the request;

generating a first response to the request based on the availability of the wireless service, the first response including one or more terms for the wireless service including at least one option between the at least two service providers; and

receiving a second response to the first response, the second response selecting at least one of the at least two service providers to provide the wireless service.

Applicants respectfully submit that *Van den Heuvel* in view of *Grube* and *Rahman* fails to teach or suggest numerous elements of this Claim.

Among other elements, *Van den Heuvel* in view of *Grube* and *Rahman* fails to teach or suggest:

selectively determining an availability of the wireless service for at least two service providers available at the geographic region based on the request; [and]

generating a first response to the request based on the availability of the wireless service, the first response including one or more terms for the wireless service including at least one option between the at least two service providers.

The Examiner admits that the combination of *Van den Heuvel* and *Grube* fails to disclose various of these elements by stating:

The combination of *Van den Heuvel* and *Grube* does not teach selectively determining an availability of the wireless service for at least two service providers available at the geographic

region based on said request, the first response also including at least one option between the at least two service providers.

Office Action, page 3. Applicants respectfully submit that the introduction of *Rahman* fails to provide the elements of Applicants' Claim 1 that the Examiner admits are not shown by *Van den Heuvel* and *Grube*.

As teaching "selectively determining an availability of the wireless service for at least two service providers available at the geographic region based on the request," the Examiner cites to *Rahman*'s discussion of multiple individual candidate service providers, where each provider determines its own tariff charge in response to a unique inquiry sent to each provider. *Rahman*, Col. 2, lines 33-36. However, determining tariff charges for service providers does not teach or suggest determining availability, let alone "selectively determining an availability of the wireless service for at least two service providers available at the geographic region based on the request."

Moreover, the proposed modification of *Van den Heuvel* based on *Rahman* would improperly change *Van den Heuvel*'s principle of operation. The operation of *Van den Heuvel* requires a bulletin board resource to periodically transmit a single menu message including information regarding available communications systems. *Van den Heuvel*, Col. 3, lines 53-57. *Van den Heuvel* makes clear that the single menu message is transmitted from "time-to-time" and not in response to any inquiry. *Id.* Furthermore, the menu message is sent by a centralized bulletin board resource and not each communication system. *Id.* The mode of operation disclosed in *Van den Heuvel* insulates individual communications systems and provides for efficient communications by avoiding redundancies. Modifying *Van den Heuvel* so that multiple individual candidate service providers each transmits its own tariff charge in response to individual inquiries, as taught by *Rahman*, would not only change the principle of operation disclosed by *Van den Heuvel*, but the benefits of utilizing a centralized bulletin board resource would also be lost. Thus, Applicants respectfully submit that the proposed modification is improper. *See* M.P.E.P. §2143.01.

These reasons apply similarly with respect to Applicants' independent Claim 46. Claims 2-15, 19, 20, 24, and 25 depend directly or indirectly from Claim 1; and Claims 48-61, 65, 66, 69, and 70 depend directly or indirectly from Claim 46. Therefore, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-15, 19, 20, 24, 25, 46, 48-61, 65, 66, 69, and 70.

Claims 88-90

The Examiner rejects Claims 88-90 under 35 U.S.C. §103(a) as being unpatentable over *Van den Heuvel* in view of U.S. Patent No. 5,581,802, which issued to Erickson et al. ("*Erickson*"), and *Rahman*.

Applicants' independent Claim 88 recites:

An interface for a mobile communication device operable to use wireless services in connection with a wireless communications network, comprising:

computer implementable instructions encoded in at least one computer processable medium; and

the instructions operable upon processing to provide a user interface configured to receive a plurality of service criteria for generating a request for wireless services at a geographic region, the service criteria comprising a geographic region, a price, a type of service, a bandwidth, and a time for the wireless service and further operable to display a response to the request comprising available wireless services and terms for the available wireless services, wherein the available wireless services are determined based on the service criteria and the terms include at least one option between at least two service providers of the requested wireless services, and wherein the user interface is further operable to receive a selection of at least one of the at least two service providers to provide the wireless service.

Applicants respectfully submit that *Van den Heuvel* in view of *Erickson* and *Rahman* fails to teach or suggest numerous elements of this Claim.

Among other elements, *Van den Heuvel* in view of *Erickson* and *Rahman* fails to teach or suggest:

a response to the request comprising . . . terms for the available wireless services, wherein . . . the terms include at least one option between at least two service providers of the requested wireless services.

The Examiner admits that the combination of *Van den Heuvel* and *Erickson* fails to disclose various of these elements by stating:

The combination of *Van den Heuvel* and *Grube* does not teach at least one option between the at least two service providers.

Office Action, page 9. Applicants respectfully submit that the introduction of *Rahman* fails to provide the elements of Applicants' Claim 88 that the Examiner admits are not shown by *Van den Heuvel* and *Erickson*.

As teaching "at least one option between at least two service providers of the requested wireless services," the Examiner cites to *Rahman*'s discussion of each candidate service provider transmitting its own tariff charge to the mobile terminal. *Rahman*, Col. 2, lines 36-40. However, each candidate service provider transmitting its own tariff charge to the mobile terminal fails to teach or suggest "a response to the request comprising . . . terms for the available wireless services, wherein . . . the terms include at least one option between at least two service providers of the requested wireless services."

Moreover, as discussed above with regard to Claim 1, the proposed modification of *Van den Heuvel* would improperly change *Van den Heuvel*'s principle of operation. The operation of *Van den Heuvel* requires a bulletin board resource to periodically transmit a single menu message including information regarding available communications systems. *Van den Heuvel*, Col. 3, lines 53-57. *Van den Heuvel* makes clear that the single menu message is transmitted from "time-to-time" and not in response to any inquiry. *Id.* Furthermore, the menu message is sent by a centralized bulletin board resource and not each communication system. *Id.* The mode of operation disclosed in *Van den Heuvel* insulates individual communications systems and provides for efficient communications by avoiding redundancies. Modifying *Van den Heuvel* so that multiple individual candidate service providers each transmits its own tariff charge in response to individual inquiries, as taught by *Rahman*, would not only change the principle of operation disclosed by *Van den Heuvel*, but the benefits of utilizing a centralized bulletin board resource would also be lost. Thus, Applicants respectfully submit that the proposed modification is improper.

Claims 89 and 90 depend from Claim 88. Therefore, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 88-90.

Claims 16, 17, 62, and 63

The Examiner rejects Claims 16, 17, 62, and 63 under 35 U.S.C. §103(a) as being unpatentable over *Van den Heuvel*, *Rahman*, and *Grube* in view of U.S. Patent No.

6,064,972, which issued to Jankowitz et al. ("*Jankowitz*"). Claims 16, 17, 62, and 63 depend from independent Claims 1 and 46 shown above to be allowable over *Van den Heuvel*, *Rahman*, and *Grube*. The introduction of *Jankowitz* fails to provide the elements of Applicants' independent Claims 1 and 46 not shown by *Van den Heuvel*, *Rahman*, and *Grube*. Thus, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 16, 17, 62, and 63.

In addition, the Examiner has not shown the required suggestion or motivation in any of the references, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention, to combine *Van den Heuvel*, *Rahman*, *Grube* and *Jankowitz*. Combining these four references, without any evidence of a suggestion, teaching, or motivation to combine, appears to be the result of taking the present invention as a blueprint for piecing together prior art to defeat patentability. This is the essence of impermissible hindsight. See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). For this additional reason, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 16, 17, 62, and 63.

Claims 18, 21, 47, 64, 67, and 91

The Examiner rejects Claims 18, 21, 47, 64, 67, and 91 under 35 U.S.C. §103(a) as being unpatentable over *Van den Heuvel*, *Grube*, *Erickson*, *Rahman*, and *Jankowitz* in view of U.S. Patent No. 6,961,569, which issued to Craport et al. ("*Craport*"). Claims 18, 21, 47, 64, and 67 depend from independent Claims 1 and 46 shown above to be allowable over *Van den Heuvel*, *Rahman*, and *Grube*. The introduction of *Erickson*, *Jankowitz*, and *Craport* fails to provide the elements of Applicants' independent Claims 1 and 46 not shown by *Van den Heuvel*, *Rahman*, and *Grube*. Furthermore, Claim 91 depends from independent Claim 88 shown above to be allowable over *Van den Heuvel*, *Erickson*, and *Rahman*. The introduction of *Grube*, *Jankowitz*, and *Craport* fails to provide the elements of Applicants' independent Claim 88 not shown by *Van den Heuvel*, *Erickson*, and *Rahman*. Thus, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 18, 21, 47, 64, 67, and 91.

In addition, the Examiner has not shown the required suggestion or motivation in any of the references, or in the knowledge generally available to one of ordinary skill in the art at

the time of the invention, to combine *Van den Heuvel*, *Grube*, *Erickson*, *Rahman*, *Jankowitz*, and *Craport*. Combining these six references, without any evidence of a suggestion, teaching, or motivation to combine, appears to be the result of taking the present invention as a blueprint for piecing together prior art to defeat patentability. This is the essence of impermissible hindsight. See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). For this additional reason, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 18, 21, 47, 64, 67, and 91.

Claims 22, 23, 68, and 92

The Examiner rejects Claims 22, 23, 68, and 92 under 35 U.S.C. §103(a) as being unpatentable over *Van den Heuvel*, *Grube*, *Rahman*, and *Erickson* in view of U.S. Patent No. 6,424,646, which issued to Gerszberg et al. ("*Gerszberg*"). Claims 22, 23, and 68 depend from independent Claims 1 and 46 shown above to be allowable over *Van den Heuvel*, *Rahman*, and *Grube*. The introduction of *Erickson* and *Gerszberg* fails to provide the elements of Applicants' independent Claims 1 and 46 not shown by *Van den Heuvel*, *Rahman*, and *Grube*. Furthermore, Claim 92 depends from independent Claim 88 shown above to be allowable over *Van den Heuvel*, *Erickson*, and *Rahman*. The introduction of *Grube* and *Gerszberg* fails to provide the elements of Applicants' independent Claim 88 not shown by *Van den Heuvel*, *Erickson*, and *Rahman*. Thus, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 22, 23, 68, and 92.

In addition, the Examiner has not shown the required suggestion or motivation in any of the references, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention, to combine *Van den Heuvel*, *Grube*, *Rahman*, *Erickson*, and *Gerszberg*. Combining these five references, without any evidence of a suggestion, teaching, or motivation to combine, appears to be the result of taking the present invention as a blueprint for piecing together prior art to defeat patentability. This is the essence of impermissible hindsight. See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). For this additional reason, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 22, 23, 68, and 92.

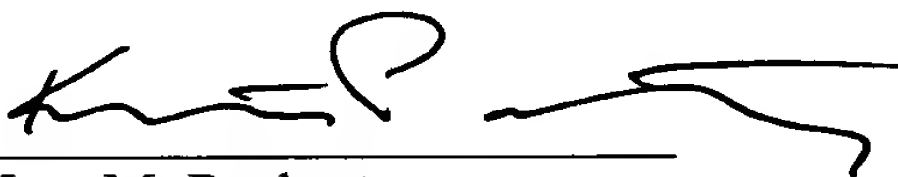
Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

No fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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